

LEXSEE 163 U.S.P.Q. (BNA) 572

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UNITED STATES PATENTS QUARTERLY

Ex parte HARVEY

No Number in Original

U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences

163 U.S.P.Q. (BNA) 572

Patent issued Oct. 7, 1969 Opinions dated Sept. 30 and Oct. 31, 1968

**CASE HISTORY and DISPOSITION:** Appeal from Group 120.

Application for patent of George R. Harvey, Serial No. 517,488, filed Dec. 29, 1965. From decision rejecting claims 1 to 9, applicant appeals (Appeal No. 827-86). Affirmed as to claim 1; reversed as to claims 2 to 9.

**HEADNOTES:**

PATENTS

[\*\*1H] 1. Amendments to patent application--New matter (13.5)

Specification--Reference to other disclosures (62.5)

Introduction into specification of serial number and filing date of copending applications referred to in specification was not new matter since description in specification of subject matter of applications and their relation to claimed subject left little doubt of identity of applications; however, acceptance of identification of applications as adequate is not a suggestion that more definite identification would not be desirable; an attorney would be well advised to utilize such means of identification as reference in application as filed to attorney's docket number and to fact that applications have same filing date, if that is a fact, as it is in instant situation.--*Ex parte Harvey (PO BdApp) 163 USPQ 572*.

[\*\*2H] 2. Board of Appeals--Issues determined (19.30)

Question not presented to Board in appeal and not discussed by examiner is not appropriate for decision by Board on petition for reconsideration.--*Ex parte Harvey (PO BdApp) 163 USPQ 572*.

Particular patents--Vinyl Azides

3,471,523, Harvey, Conjugated Vinyl Azides and Their Preparation, claims 2 to 9 of application allowed; claim 1 refused.--*Ex parte Harvey (PO BdApp) 163 USPQ 572*.

**CLASS-NO:** 13.5, 19.30, 62.5

**COUNSEL:** NEAL E. WILLIS, JOHN J. HENSCHKE, JR., DONALD J. HAEFELER, EDWARD P. GRATTAN, and DAVID D. CENTOLA, all of St. Louis, Mo., for applicant.

**JUDGES:** Before ASP, MAGIL, and BEHRENS, Examiners in Chief.

**OPINIONBY:** BEHRENS, Examiner in Chief.

**OPINION:**

This is an appeal from the examiner's decision finally rejecting claims 1 to 9 directed to certain azides.

The following references are relied on to support the examiner's rulings:

Dorland's Illustrated Medical Dictionary (Saunders Co., Phila., 24th Ed., 1965), page 589.

Smith, The Chemistry of Open-Chain Nitrogen Compounds, Vol. II (Benjamin, New York, 1966) pages 215-9.

Webster's Third New International Dictionary, page 1058.

Claim 1 was rejected "under 35 U.S.C. 132 as being based on new matter inserted into the examples of the specification." Amendments to the specification changed the names of certain azides, particularly in Examples 17 and 20. These names, which, appellant states were originally incorrect, were the only identification of the compounds since none of the usual data, i.e., melting point, boiling point, density or color, was given for the compounds in question.

We agree with the examiner, for the reasons that the Examiner's Answer adequately explains, that on the record the proposed changes amounted to new matter and left in doubt the disclosure supporting claim 1.

In a reply brief appellant argues that the examiner's acceptance of the changes made in certain examples indicates the system of nomenclature used by appellant's specification. Appellant asserts (reply brief, page 2) "It is inconceivable that appellant would use one nomenclature in Examples 15 and 16 and another in Example 17."

Appellant's argument is self defeating. Appellant's reactant in Example 15, originally alpha-methyl butadienyl phenone, became 2-methyl-2,3- butadieno -phenone on amendment, consistent with the structural formula. In Example 17, where no structural formula limited the description, the original reactant, 2,3- butadienyl-p -bromophenone, became 4'-bromo-2,3- pentadieno -phenone, a com [\*573] pound having one more carbon atom than the reactant of Example 15. Evidently the basis for correction or amendment must be purely subjective and not a matter of reasoning from the record.

We will affirm this rejection.

Go to Headnotes [\*\*1R] [1] All claims were finally rejected under 35 U.S.C. 132 because of the new matter introduced into the application filing in the serial number and filing date of the two applications referred to on page 1 of the original specification.

We will not sustain this rejection on the basis of the facts of this case. We believe the appellant's copending application and that of appellant Harvey and Kenneth Wayne are sufficiently identified in the second and third paragraphs of the specification. The description of the subject matter of the two applications and their relation to the claimed subject left little doubt, taking into account the nature of this subject matter, of the identity of the applications. Each of the two applications referred to a copending Harvey application as a source of the starting materials used.

Our acceptance of the identification of the copending applications as adequate under all the circumstances of this appeal is not a suggestion that more definite identification would not be desirable. An attorney would be well advised to utilize such means of identification as reference in the application as filed to the attorney's docket number and to the fact that the applications have the same filing date, if that is a fact, as it is here.

The examiner, we note, suggests that the Harvey application is not properly identified by the reference in the second paragraph of the specification because this reference refers to useful "fungicides" and application Serial No. 517,438 refers to its chemicals "useful in inhibiting the growth of fungus," an expression indicating "fungistatic" use. This, as recognized by the court in *In re Johnson* (CCPA, 1960), 1960 C.D. 551, 282 F.2d 370, 760 O.G. 1041, 127 USPQ 216, gives too narrow a meaning to the term "fungicide".

Claims 1 to 9 were also rejected "as being based on a disclosure which fails to describe how to use the invention, 35 U.S.C. 112, paragraph 1, and 35 U.S.C. 101."

We will not sustain this rejection. The compounds are described (page 1, first paragraph) as being directed to the preparation of chemicals useful in inhibiting the growth of fungus. Appellant's copending application, which is referred to and identified on the specification (page 1, second paragraph) describes azirine derivatives, prepared by ultraviolet irradiation of appellant's product compounds, as being fungicides. In view of *In re Johnson*, *supra*, which found an adequate description of utility in a description of the claimed compounds as being fungicides, we would assume that the utility of "fungicides" under 35 U.S.C. 101 or 35 U.S.C. 112, is not an open question in the absence of evidence that establishes a distinction which we can honor. The examiner's comment on the recognition of the inclusive nature of the term fungicide in *In re Johnson*, is undoubtedly accurate but it does not point to such a distinction between the situation in the Johnson case and that in the present.

The decision of the examiner is affirmed as to claim 1 and is reversed as to claims 2 to 9.

Oct. 31, 1968

ON PETITION FOR RECONSIDERATION Appellant has petitioned for reconsideration of our decision affirming the rejection of claim 1 as being based on new matter.

The petition suggests that the location of the alpha-benzyl radical in the reactant and product of Example 20 is not in doubt. This is probably true but the reasoning that supports the correction of Example 20 in the manner indicated is not consistent with the reasoning that would make the modified Example 17 reactant and product consistent with the original disclosure. Appellant, in correcting mistakes must be consistent or we must assume that there is no rationale justifying correction.

Go to Headnotes [\*\*2R] [2] Petitioner "offers, with the Board's approval, to cancel the amended material (Examples 17 and 20), thus clearing the way for allowance of claim 1." Implicit in this "offer" is a suggestion that the Board make a decision on the question whether the specification without Example 17 or without Examples 17 and 20 would support claim 1. This question is not presented to us in this appeal and has not been discussed by the examiner. It is not appropriate for decision on petition.

The petition for reconsideration is granted to the extent that we have reviewed our decision in the light of petitioner's arguments and it is otherwise denied.